

REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 1-19 were pending. By the present response, claims 1, 4-6, 10, 13, 14, 16 and 19 have been amended; claims 3, 7, 9, 11, 12, 15, 17, and 18 canceled; and claims 20-26 added. Thus, upon entry of the present response, claims 1, 2, 4-6, 8, 10, 13, 14, 16, 19 and 20-26 are pending and await further consideration on the merits.

Support for the foregoing amendments can be found in at least the original claims.

Applicants thank Examiner Ruhl for the courtesies extended to Applicants' representatives during a personal interview conducted on June 12, 2006. During the interview, the issues of support and indefiniteness were discussed. The present response attempts to utilize this productive discussion to address and resolve the issues noted in the non-final Office Action of December 27, 2005.

I. SUPPORT ISSUES RAISED IN THE DECEMBER 27, 2005 NON-FINAL ACTION

A. Legal Principles

In order for a claim presented in a later-filed application to be entitled to the filing date of an earlier-filed application under 35 U.S.C. § 120, the earlier application must satisfy the written description requirement of 35 U.S.C. § 112 with respect to the later-filed claim. *Lampi Corp. v. American Power Products, Inc.*, 228 F.3d 1365, 56 USPQ2d 1445 (Fed. Cir. 2000).

A written description, as filed, is presumed to satisfy the requirements of 35 U.S.C. §112, first paragraph, unless sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). Therefore, the Examiner must have a reasonable basis to challenge the adequacy of the written description and has the initial burden of presenting, by a preponderance of the evidence, an explanation as to why one of ordinary skill in the art would not recognize that an Applicant's disclosure adequately describes the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

The written description requirement does not mean that there must be *ipsis verbis* support. *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972). The written description requirement is satisfied if one of ordinary skill in the art would have understood the inventor(s) to be in possession of the claimed subject matter at the time of filing, even if every nuance of the claims is not explicitly described in the specification. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). Thus, information which is well-known in the art need not be described in detail in the specification. *Hybriotech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379-80, 231 USPQ 81, 90 (Fed. Cir. 1986).

An adequate written description may be provided by any portion of the disclosure so long as one of ordinary skill in the art would recognize that the inventor had possession of the claimed invention. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000). Therefore, an applicant can show possession of invention through drawings which are sufficiently detailed to

show that applicant was in possession of the claimed invention as a whole. *Vas-Cath*, 935 F.2d at 1565, 19 USPQ2d at 1118.

A claim limitation appearing in means-plus-function format in accordance with the provisions of 35 U.S.C. §112, sixth paragraph, does not invoke any additional requirements beyond those typically imposed by 35 U.S.C. §112, first paragraph. *In re Knowlton*, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). Support for a means-plus-function claim limitation which satisfies the written description requirement exists so long as:

- (1) the written description adequately links or associates adequately described particular structure, material, or acts to the function recited any means-(or step-) plus-function claim limitation; or
- (2) is clear based on the facts of the application that one skilled in the art would have known what structure, material, or acts perform the function recited any means-(or step-) plus-function limitation.

M.P.E.P. §2163

With regard to the separate issue of the scope of a means-plus-function limitation, such a limitation is interpreted to cover the structure, materials, or acts corresponding to the recited function appearing in the specification and equivalents thereof. *B. Braun Medical, Inc. v. Abbott Lab.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed.Cir.1997).

It is alleged on pages 2-6 of the Official Action that the pending claims are entitled to a filing date of August 2, 1994, instead of the original filing date of April 1, 1991. These assertions are respectfully traversed as set forth below.

B. Support for "means for inputting information" in the 07/678,863 Disclosure

Claims 1, 5, 10, 13, 14, 16 and 19 of the present application each contain the phrase "means for inputting information." This phrase is clearly supported by the 07/678,863 disclosure (hereafter "the '863 disclosure"). For example, as discussed in the '863 disclosure:

"In operation, the machine conducts a dialog with a user/customer, via a touch screen and a digitized voice output (or other input/output devices), to obtain information about the customer's intended shipment address, class of service, and the like." (Page 1, Lines 15-18)

"the customer's responses on the touchscreen 110 or other input device (e.g., a conventional computer keyboard) are used in controlling the machine's operations." (Page 10, lines 5-8) . . .

"input means" (claim 1, subparagraph (c))

Reference is made to the table attached hereto as **Exhibit A** for a more comprehensive identification of the basis for support for the "means for inputting information" phrase in the disclosure.

From the above, it is clear that the '863 disclosure adequately links or associates the function of inputting information with the corresponding structure of a touchscreen, keyboard, or their equivalents. Therefore, the written description requirement of 35 U.S.C. § 112, first paragraph, has been satisfied, and this phrase is entitled to the April 1, 1991 priority date afforded by the '863 disclosure.

On page 3 of the Official Action it is alleged that "the specification from 07/678,863 discloses a touchscreen or a conventional computer keyboard as being the input mechanism but the word 'means' was never used." This assertion is respectfully traversed. The original claim of the '863 application constitutes a part of the original disclosure thereof. Claim 1, as originally presented in the '863 application, reads as follows:

1. An automated self-service package shipping machine comprising:
 - (a) means for receiving a package;
 - (b) screen-display means for displaying user instructions;
 - (c) user **input means** for transmitting user preferences;
 - (d) means for printing a destination label;
 - (e) means for printing a customer receipt; and
 - (f) locking means for securing the package.

As evident from the above, and contrary to the assertions contained on page 3 of the Official Action, the '863 application as originally filed clearly and explicitly discloses "input means."

It is further alleged in the Official Action that the disclosure of the present application (08/720,927) for the first time discloses a voice recognition system, and that the scope of the "means for inputting information" is different in the current application that it is in the '863 application. For this reason, it is asserted that the "means for inputting information" phrase is not entitled to the filing date of April 1, 1991, of the '863 application. This assertion is respectfully traversed because it is incorrect as a matter of law.

Initially, it is important to note that the Official Action does not allege that the '863 disclosure fails to provide written description support for the claim phrase "means for inputting information." Instead, the position taken in the Official Action attempts to add an additional legal requirement to obtain the benefit of the '863 application filing date. Namely, the position taken in the Official Action is that not only must the earlier disclosure provide written description support for the claim, but that that support must have the same scope as the support contained in a later-filed application. The comments contained in the Official Action evidence confusion over the separate issues of interpretation of the scope of a means-plus-function limitation

and the issue of whether it is supported (i.e., satisfies the written description requirement in the earlier disclosure).

The legal test that must be satisfied in order for a means-plus-function limitation to satisfy the written description requirement is set forth in section I.A. above. As evident upon review of this standard, there is simply no legal requirement that the support for a means-plus-function limitation of an earlier-filed application be the same as the support contained in the later-filed application. Should the position be maintained, it is respectfully requested that controlling legal authority be cited in support of the assertions made on page 3 of the Official Action denying the above quoted claim phrase the benefit of the filing date of April 1, 1991.

With respect to newly presented claims 20-26, it is noted that the "means for inputting" phrase has been replaced by a structural recitation of "a keyboard or touch screen." See, **Exhibit B**. Thus, the above-mentioned written description objection is not applicable to claims 20-26.

C. Support for "means for communicating" the charges information, and communication of this information via phone lines

The above-referenced phrases are supported for example, by the following portion of the original disclosure of the '863 application:

Using these measurements and the customer provided information, the machine computes the postage or other shipping charge. . . The machine obtains payment from the customer, notably though the use of a prepaid, low-cost charge card which may be sold in convenient denominations at the machine's location (e.g., at a convenience store). A magnetic card reader for handling such cards may be connected through a conventional interface directly to, e.g., a convenience-store cash register. Alternatively, the customer may use a credit card to make payment. (Page 1, Lines 26-36)

In connection with the above-quoted portion of the specification of the '863 disclosure, reference is made to the drawing Figures, which provides even further support for the above-mentioned claim phrases. Specifically, reference is made to Figures 12a-12c which illustrates a hardware configuration which is clearly associated with the recited function(s) of assessing the shipment fee to the account of a person, as well as communicating the charges via phone lines, and printing a hard copy of the account charge for the person. Figure 12a illustrates letter and package scales (138, 228) connected to a "V/F weigh card" (1202), which is connected to a bus (1200). Figure 12b illustrates a computer (1201) connected to the bus (1200). A "Mckey credit card reader" (emphasis added) (122) as well as the touch screen/monitor (110) are in turn connected to the computer (1201), which is connected to the PC bus (1200), which is connected to a modem (1262), which in turn is connected to the telephone line (1264).

The flowcharts appearing in Figures 18a-26 also provide additional support for the above-quoted phrase. For example, as illustrated in Figure 19a-19b, the system described in the '863 disclosure functions to "read card balance," "weigh letter," "display of charges," "compare to balance on card," "deduct amount from card," "print receipt," "finish," and "receipt return card."

From the above-cited text and Figures, it would have been immediately apparent to those of ordinary skill in the art that the system which is disclosed in the '863 application as accepting payment by credit card, and which discloses a credit card reader operatively connected to phone lines (for transmission of charges) includes communicating and assessing the charges to the account of the credit card holder. The written description requirement is satisfied by reasonably providing

notice to those of ordinary skill in the art that the Applicants had possession of the above-quoted phrases.

Reference is hereby made to the table attached hereto as **Exhibit A** for a more comprehensive identification of exemplary bases for support for the above.

E. Support for means for communicating the charges information to a "central location" for billing the charges to said customer in the '863 Disclosure

The above-quoted phrase finds support on page 1 of the '863 disclosure, where it is stated: "Alternatively, the customer may use a credit card to make payment." See page 1, lines 31-36 of the '863 disclosure. In addition, Figures 12a-12c provide a detailed disclosure of a system in which credit card payment can be made via phone lines to a central location. For instance, element 122 is labeled in Figure 12b as a "McKey Credit Card Reader." The credit card reader (122) is connected to the PC bus (1200), which is connected to a modem (1262), which in turn is connected to the telephone line (1264). The combination of the above-identified portions of the '863 disclosure adequately links or associates the particular structure or arrangement for communicating charges to a central location and for assessing the shipment fee to the (credit card) account of a user, and makes it clear to those of ordinary skill in the art what structure performs the recited function. See, e.g., (i) U.S. Patent No. 4,359,631; (ii) Lewis Mandell, "The Credit Card Industry: A History," Twayne Publishing, 1990; and (iii) VISA/About VISA/History, from <http://usa.visa.com/about-visa/about-visa-usa/history.html>, 5/23/06.

F. Support for "means for storing the inputted information once said item is disposed in said secured storage means" in the '863 Disclosure

As illustrated in Figures 1, 3 and 5 of the '863 application, the package is first placed into a "first zone" through the package window 106 and placed on, for example, a tilting package scale assembly 140 ("the package window door 106 opens, a customer puts the package inside the window on the package/scale/tilt assembly 400"). See page 11, lines 14-16, of the '863 application. Once the customer has completed processing of the package, the package window door 106 is automatically closed (page 11, lines 22-23), and the automatic tilting assembly 400 transfers the package from the above-described first zone to a second secure area or zone 410 (see Figure 6).

As described in both the specification and drawing Figures of the '863 application, the system clearly includes means for storing inputted information associated with the item that has been placed in the secure storage area. The system described in the '863 disclosure includes a computer (1201) that includes a RAM. See, e.g., Figure 12b. As described on page 2, lines 26-28: "a convenience store clerk inputs and appropriate instruction at the 'end of the day,' a hard-copy manifest of packages received by the machine is generated."

Further, as illustrated for example in Figure 26, a manifest may be generated from the information stored by the device or system. Note the options for "print previous manifest" and "search for a shipment." In order to retrieve such information, it must have been stored by the system or device. See also, Figures 18b, 19b, 20b, 21b, 23a-b, 24b.

Therefore, the '863 disclosure satisfies the written description requirement because it adequately links or associates the above-mentioned structure to the

function recited in the means-plus-function claim limitation, and it is clear, based at least upon the facts recounted above and contained in the '863 application disclosure, that one skilled in the art would have known what structure(s) perform the function recited in the above-quoted means-plus-function phrase.

Moreover, by the present response, Applicants have amended this phrase in a non-narrowing manner in an effort to address the concerns raised on page 5 of the Official Action. In particular, the term "once" has been deleted and alternative language substituted.

Newly presented claims 21, 22, 25 and 26 also omit the term "once" and utilize similar alternative language. Claims 21, 22, 25 and 26 also substitute the structural phrase "a memory" for the objected to "means for storing." See **Exhibit B**. Thus, the above-mentioned objection is inapplicable to claims 20-26.

G. Support for Claims 7, 9 and 11 in the '863 Disclosure

It is asserted on pages 5-6 of the Official Action that various features contained in claims 7, 9 and 11 of the present application lack support in the '863 disclosure. In order to expedite prosecution, claims 7, 9 and 11 have been canceled without prejudice. By cancellation of these claims, Applicants do not concede to the correctness of the assertions contained on pages 5-6 of the Official Action. Applicants further expressly reserve the right to rejoin these claims at a future date in the course of these proceedings.

II. CLAIM REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 1-19 stand rejected under 35 U.S.C. §112, second paragraph for being indefinite on various grounds set forth on pages 6-10 of the Official Action. These rejections are respectfully traversed.

Claims 1, 13 and 14 stand rejected on the grounds set forth on page 6 of the Official Action. Namely, on the basis that the claim language relating to "said communication means" is unclear with respect to what this phrase is referring. Claims 1, 13 and 14 have been amended in a non-narrowing manner which obviates the above-noted antecedent basis issue. Reconsideration and withdrawal of the rejection is respectfully requested.

The claim phrase directed to "charges information" is objected to on the grounds set forth on pages 6-7 of the Official Action. The grounds for rejection fail to specify which claims are rejected on this basis. Applicants respectfully request that the grounds for rejection be clarified in a future non-final Official Action.

Notwithstanding the above, Applicants have amended the claims in a non-narrowing manner which is believed to clarify what is meant by the charges, and addresses the concerns expressed on pages 6-7 of the Official Action. Thus, reconsideration and withdrawal of the rejection is respectfully requested.

The claims also stand rejected on the basis that the claims recite a "storage area" and "secure deposit means" as different elements, when they are allegedly part of the same aspect of the presently claimed invention. This rejection is set forth on page 7 of the Official Action. Again, the specific claims which have been rejected on this basis are not identified. Applicants respectfully request that the grounds for

rejection be clarified by specifically identifying each claim rejected on this basis in a future non-final Official Action.

Notwithstanding the above, Applicants have amended this language in a non-narrowing manner to clarify that the storage area comprises the secure deposit means (e.g., first zone and second zone), which is believed to address the objections set forth on page 7 of the Official Action. Thus, reconsideration and withdrawal of the rejection(s) is respectfully requested.

It is asserted on page 7 of the Official Action that claims 3 and 15 are unclear because the phrase "said means for communicating" is unclear. Applicants have canceled claims 3 and 15, thereby obviating the above-noted grounds for rejection. Notwithstanding the above, Applicants traverse the rejection and expressly reserve the right to reintroduce these claims at a later date should the circumstances warrant.

Claim 4 is rejected on the basis that the language "said means outer housing" is indefinite. By the present response, Applicants have amended claim 4 in a non-narrowing manner by deleting "means" from the above-quoted phrase, which is believed to address the grounds for rejection. Thus, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 5, 10 and 19 are rejected on grounds that the language "said means for communicating the shipment fee being by telephone lines" is unclear. Applicants have amended this language where it appears in the claims in a manner which, while non-narrowing, is believed to remove the above-noted objection. Namely, Applicants have changes "being by" to "comprising." Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 6 stands rejected on the grounds that the claim phrase "said manifest" lacks antecedent basis. Claim 6 has been amended to remove the lack of antecedent basis objection, thereby obviating the rejection.

Claims 9 and 11 stand rejected on grounds that the claim phrases "means for validating said credit card prior to issuing the shipping label" and "means for validating said account prior to issuing the shipping label" are unclear. Claims 9 and 11 have been canceled. Applicants expressly reserve the right to reintroduce these claims at a later date should the circumstance warrant.

Claims 12 and 16 stand rejected on the grounds that the phrase "said account charge" has no antecedent basis. Claim 12 has been canceled without prejudice, and claim 16 amended in a manner which, while not narrowing the scope thereof, obviates the above-noted grounds for rejection. Thus, reconsideration and withdrawal of the rejection of claim 16 is respectfully requested.

Claims 13 and 14 stand rejected on grounds that the phrases "the charges information" and "the charges" lack antecedent basis. Claims 13 and 14 also stand rejected on the basis that the last paragraph thereof is allegedly unclear for referring to the storage area and secure deposit means as defining separate elements, but then linking the first zone back to the storage area. Claims 13 and 14 have been amended to clarify what is meant by the charges, and recites that the storage area comprises the secure deposit means (e.g., first zone and second zone). Thus the claims have been amended in a manner, while not narrowing the scope thereof, obviates each of these grounds for rejection.

Claim 14 also stands rejected on the basis that the phrase appearing therein which reads "said weighing means supported by said system" allegedly "makes no

sense." This rejection is respectfully traversed. The rejection is based upon the assertion that since the weighing means comprises part of the system, it cannot support itself. However, this interpretation incorrectly assumes that the weighing means must be supported by the entire system. Applicants respectfully submit that the claim contains no such limitation. Namely, the above-quoted claim language can properly be interpreted such that one or more parts of the system, other than the weighing means, acts to support the recited weighing means. There is nothing inconsistent with interpreting the weighing means as composing a part of the system as well as being supported by the system. Thus, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 16 and 19 stand rejected on grounds that the phrase "to the account of the person" has no antecedent basis. It is also asserted that the language "said means assessing comprising means for printing" is unclear, and the phrase "said account charge" lacks antecedent basis. Claims 16 and 19 have been amended in manner which obviates these lack of antecedent basis objections, thereby obviating the grounds for rejection.

Claim 17 stands rejected on the grounds that it is unclear whether the phrase "means for communicating" is different from the previously recited "means for communicating and assessing." Claim 17 has been canceled without prejudice. Thus, the above-noted grounds of rejection of claim 17 have been obviated.

III. CLAIM REJECTION UNDER 35 U.S.C. §102

Claims 1-19 stand rejected under 35 U.S.C. § 102 (e) as anticipated by U.S. Patent No. 5,481,464 to Ramsden (hereafter "*Ramsden*"). This rejection is respectfully traversed.

As explained in section I above, claims 1-19 of the present application are entitled to an effective filing date of April 1, 1991. By contrast, the vast majority of the subject matter contained in *Ramsden* which is relied upon to reject the claims of the present application as an effective filing date of August 23, 1994. In fact, the earliest possible effective filing date for the subject matter being relied upon in the grounds for rejection is August 3, 1993.¹ Thus, since the claims of the present application have a filing date which antedates the earliest possible effective filing date of *Ramsden*, the rejection is improper since *Ramsden* fails to qualify as prior art under 35 U.S.C. §102(e). Reconsideration withdrawal of the rejection is respectfully requested.

IV. REQUEST FOR INFORMATION PURSUANT TO 37 C.F.R. § 1.105

In paragraph 5 (page 11) of the Official Action of December 27, 2005, a request was made pursuant to 37 C.F.R. § 1.105 (a)(1)(viii) to provide "a detailed explanation that addresses the scope of each and every limitation found in the claims (i.e., what does the "means" language cover as far a structure goes)."

In response, Applicants submit a table attached hereto as **Exhibit A** providing a detailed explanation of the above-mentioned claim phrases. Applicants believe

¹ While Applicant's refer to the filing date of August 3, 1993, as the earliest possible effective filing date, it is not asserting that *Ramsden* is in fact entitled to the benefit of that filing date for any particular claim or invention.

that the table of **Exhibit A** satisfies the request for information pursuant to 37 CFR § 1.105.

Additional information concerning the bases for the declaration of an interference is forthcoming in a Request for Interference. The Examiner is requested to contact the undersigned prior to further action to schedule a time for filing and discussing the Request for Interference.

V. NEW CLAIMS

Newly presented claims 20, 21, 22, 23, 24, 25 and 26 have been derived from previously presented claims 1, 5, 10, 13, 14, 16 and 19, respectively. **Exhibit B** comprises a table comparing these claims on a limitation-by-limitation basis and is submitted herewith to facilitate the Examiner's analysis. It is respectfully submitted that newly presented claims 20-26 are also patentable, and entitled to an effective filing date of April 1, 1991, for at least the same reasons noted previously herein.

VI. CONCLUSION

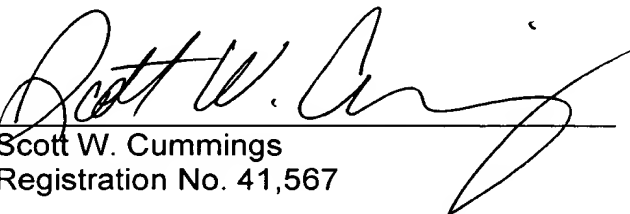
From the foregoing, further and favorable action is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BUCHANAN INGERSOLL PC

Date: June 26, 2006

By:



Scott W. Cummings
Registration No. 41,567

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620